

## **REMARKS**

Applicant thanks the Examiner for the detailed Office Action dated April 29, 2008. Applicant respectfully requests reconsideration of the present application in view of the amendments to the claims and for the reasons that follow.

For simplicity and clarity purposes in responding to the Office Action, Applicant's remarks are primarily focused on the rejections to the independent claims outlined in the Office Action with the understanding that the claims that depend from the independent claims are patentable for at least the same reasons that the independent claims are patentable. Applicant expressly reserves the right to argue the patentability of the dependent claims separately in any future proceedings.

### **Claim Rejections under 35 U.S.C. § 102**

#### ***Law of Anticipation***

The PTO acknowledges the legal standard that a "claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Further, the "identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). See MPEP § 2131. In general, in deciding the issue of anticipation, the trier of fact must identify the elements of the claim at issue, determine their meaning in light of the specification, and identify corresponding elements disclosed in the allegedly anticipating reference.

#### **Applicant's Independent Claim 1**

Applicant's claims 1 and 3 were rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent number 6,341,527 (Ishikura et al.). Applicant respectfully traverses this rejection for the following reasons.

Applying the legal standard for anticipation outlined hereinabove, it is respectfully submitted that Ishikura et al. does not identically disclose the combination of elements recited in Applicant's claim 1. For example, Ishikura et al. does not disclose "a conductive standoff sandwiched between the substrate and the second electrode **for maintaining the second electrode in spaced relation to the first electrode**".

On pages 13-14 of the subject Office Action, the Examiner suggests that the extraction electrodes 104 need only be **capable of maintaining the second electrode in spaced relation to the first electrode** in order to disclose Applicant's Claim 1. The Examiner has not provided any support for this position and it is inconsistent with the plain meaning of the claim language. Clearly a claim limitation that is "adapted to maintain the second electrode in spaced relation to the first electrode" is distinguishable from a limitation that is "capable of maintaining the second electrode in spaced relation to the first electrode. Additionally, even if the Examiner's interpretation were correct, it is suggested that the extraction electrode 104 relied on by the Examiner is not capable of maintaining the second electrode in spaced relation to the first electrode for the following reasons.

There is no support in the Ishikura et al. reference for the position that the extraction electrode 104 is capable of maintaining the second electrode in spaced relation to the first electrode. For example, neither the Examiner nor the Ishikura et al. reference has provided any evidence that the extraction electrode 104 comprises a material that is strong enough to maintain the second electrode in spaced relation to the first electrode, or that the geometry of the extraction electrode 104 is suited for maintaining the second electrode in spaced relation to the first electrode. In other words, the extraction electrode 104 does not appear to be designed as or capable of being a load bearing member, and there is no support whatsoever for this position.

The Ishikura et al. substrate layers (e.g., layers 2 & 3, or layers 102 & 103) maintain the second electrode in spaced relation to the first electrode. These substrate layers structurally engage to form the separation of the electrodes, while the extraction electrode 104 is merely disposed between the substrate layers. The extraction electrode 104 of the Ishikura et al. reference is incapable of maintaining the second electrode in spaced relation to the first electrode

because it is prevented from doing so by the substrate layers. The extraction electrode 104 is an electrical contact, not a structural element.

Ishikura et al. also fails to disclose “a second electrode positioned on the first side of the substrate in a spaced relation to the first electrode, at least part of the second electrode configured to move toward or away from the first electrode **in response to a uterine contraction**” as required by Applicant’s amended claim 1.

It has been shown that Ishikura et al. does not include every element as set for the in Applicant’s amended claim 1, which is therefore patentable. As claims 3 and 11 depend upon claim 1, they are also patentable. Applicant’s therefore respectfully request the withdrawal of the rejection of claims 1 and 3 under 35 U.S.C. § 102(e).

Applicant’s claims 1 and 3 were also rejected under 35 U.S.C. § 102(e) as being unpatentable over U.S. Patent number 6,604,425 (Hsu et al.). Applicant respectfully traverses this rejection for the following reasons.

Applying the legal standard for anticipation outlined hereinabove, it is respectfully submitted that Hsu et al. does not identically disclose the combination of elements recited in Applicant’s claim 1. For example, Hsu et al. does not disclose “a second electrode positioned on the first side of the substrate in a spaced relation to the first electrode, at least part of the second electrode configured to move toward or away from the first electrode **in response to a uterine contraction**”.

It has been shown that Hsu et al. does not include every element as set for the in Applicant’s amended claim 1, which is therefore patentable. As claims 3 and 11 depend upon claim 1, they are also patentable. Applicant’s therefore respectfully request the withdrawal of the rejection of claims 1 and 3 under 35 U.S.C. § 102(e).

### **Claim Rejections under 35 U.S.C. § 103**

#### ***Law of Obviousness***

35 U.S.C. § 103(a), the statutory basis for obviousness rejections, states:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this

title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In re Finc, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). If the Examiner's burden is met, the burden then shifts to the Appellant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

#### **Applicant's Independent Claim 4**

Applicant's claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsu et al., in view of U.S. Patent number 4,158,217 (Bell). It is respectfully suggested that no combination of Hsu et al. and Bell disclose Applicant's claim 4. More precisely, no combination of Hsu et al. and Bell disclose "a second electrode positioned on the first side of the substrate in a spaced relation to the first electrode, at least part of the second electrode configured to move toward or away from the first electrode; wherein: the second electrode includes a **plurality of channels forming a spring mechanism** in a body".

The nonconductive areas 8 and 10 of the Bell reference that allegedly disclose Applicant's channels are structurally and functionally distinguishable. There is no support in the Bell disclosure for the position that the nonconductive areas 8 and 10 are capable of forming a spring mechanism.

Applicants respectfully submit that the subject matter recited in independent claim 4 would not have been obvious to a person of skill in the art and is patentable. As claims 5-10 depend from claim 4, they are also patentable. Accordingly, Applicant requests withdrawal of the rejection of claims 4-10.

**Applicant's Dependent Claim 10**

Applicant's claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hsu et al., in view of Bell and U.S. Patent number 5,836,063 (Hegner et al.). It is respectfully suggested that no combination of Hsu et al., Bell and Hegner et al. disclose Applicant's claim 10. More precisely, no combination of Hsu et al., Bell and Hegner et al. disclose a conductive sheet on each side of the substrate wherein "the conductive sheets in combination with the second electrode are configured to form an electric shield around the first electrode".

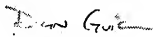
On page 11 of the subject Office Action, the Examiner alleges that reference numbers 17 and 27 of the Hegner et al. reference disclose Applicant's conductive sheets. Hegner et al. reference number 17 is an electrode and reference number 27 is a terminal of the electrode 17 (see column 5, lines 25-26). It is respectfully suggested that the Hegner et al. terminal 27 cannot, according to a plain meaning interpretation of the term and the pictorial representation shown in Figure 1, be said to disclose Applicant's conductive sheet. In other words, as shown in cross-section in Figure 1, the Hegner et al. terminal 27 comprises a small circular configuration that is distinguishable from Applicant's sheet.

Additionally, there is no support in the Hegner et al. disclosure for the position that the electrode 27 and the terminal 17 are capable of forming "an electric shield around the first electrode" as required by Applicant's amended claim 10.

Applicants respectfully submit that the subject matter recited in dependent claim 10 would not have been obvious to a person of skill in the art and is patentable. Accordingly, Applicant requests withdrawal of the rejection of claim 10.

Respectfully submitted,

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Daniel Guiser  
Registration No. 52,514

CORRESPONDENCE CONTACT INFORMATION:

Daniel Guiser  
G.E. Healthcare  
20225 Water Tower Blvd., Mailstop W492  
Brookfield, WI 53045  
Telephone Number: (262) 957-3788